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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,646	09/23/2003	Dale Andersen	D25.2H-11301-US01	2035

490 7590 07/22/2005

VIDAS, ARRETT & STEINKRAUS, P.A.  
6109 BLUE CIRCLE DRIVE  
SUITE 2000  
MINNETONKA, MN 55343-9185

EXAMINER
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FOSTER, JIMMY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/668,646

Applicant(s)

ANDERSEN ET AL.

Examiner

Jimmy G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 26-37 is/are rejected.
- 7) ☒ Claim(s) 24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/29/03</u> | 6) <input type="checkbox"/> Other: ____  |

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1) The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2) Claims 1, 5-10, 12, 15, 17, 19, 22, 23, 26-31, 33 and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Schutz et al (5,370,233).

In the reference of Schutz et al, there are provided plural support members 14 (any of which including first and second support members), support member walls 18,20,22,24 for each support member, a support member bottom wall/support surface 16, plural containers/sleeves 52 on the support surfaces 16, and a pad/top cap 60 on the containers. These elements define an assembly.

Inasmuch as the support members 14 of the assembly of Schutz et al are two deep and three side-by-side, the support walls of the support members may be considered to include left walls adjacent to left walls, right walls adjacent to right walls, left walls adjacent right walls, front walls adjacent front walls, back walls adjacent back walls, and front walls adjacent back walls.

The pad/top cap 60 includes walls on all sides thereof.

Additionally there is provided a heat-shrink film 68 at least partially encapsulating the assembly.

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3) The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schutz et al (5,370,233) in view of official notice that it is known to provide advertisement and identification on the exterior of packaging for providing information of the contents of the package. Accordingly, it would have been obvious in view of this function to have provided indicia on the exterior of the assembly of Schutz et al. To have provided the indicia in any particular location, including on the walls of the pad 60, would have been obvious as providing a mere change in location without substantial change in the function of providing information, since it has been held that rearranging parts of an invention involves only routine skill in the art, *In re Japikse*, 86 USPQ 70.

5) Claim 35 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schutz et al (5,370,233) in view of Becker et al (3,385,429). The reference of Becker et al, at col. 2, lines 51-55, suggests that overwrap films may be made transparent to promote content identification through the material of the wrap. Accordingly, it would have been obvious in view of this function to have made the film of Schutz et al transparent.

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6) Claim 37 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schutz et al (5,370,233) in view of Duerr (4,077,516). Figures 5-7 of Duerr suggest that a film over-wrapping plural containers may be made opaque. This suggestion is evident from the fact that the visible demarcation between containers is only visible through the opening in the film. The purpose is also evident: to make the appearance of the package primarily reliant on the appearance of the film. Accordingly, it would have been obvious in view of Duerr to have made the over-wrap film of Schutz et al opaque to use the surface of the film more for the appearance of the assembly.

7) Claims 2-4, 11, 13, 14, 16, 18, 20 and 21 distinguish over the prior art since the prior art does not suggests including tapering walls with pads, in an assembly such as recited by Applicant.

8) Claim 24 and 25 are objected to as being dependent on a rejected claim, but would be allowable if amended to include all of the limitations of the base claim and any intervening claim.

9) The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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10) Claims 1-9 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 4 of U.S. Patent No 6,588,594. Although the conflicting claims are not identical, they are not patentably distinct from each other because inasmuch as patent claim 1 includes all or most of the subject matter set forth in many the present claims, and any difference would have been obvious, it would have been obvious to have made the invention of the present claims in view of the patent claims. Patent claim 1 calls for first and second support members, tapering support member walls for each support member, a support surface, plural containers on the support surfaces, a pad on the containers a film at least partially encapsulating the assembly of the support members containers, and pad. Patent claim 2 calls for there to be four edges (which would define four sides).

Regarding present claim 3, which calls for the taper of the walls to be an arcuate taper, the description refers to this as a style of taper. Moreover, regarding claim 4 the recited linear taper would appear to be the opposite kind of style. A change in aesthetic design, however, generally will not support patentability (see In re Seid, 73 USPQ 431). Accordingly, it would have been obvious in view of this to have made the taper of any the walls of the patent claims with any shape/style, including the arcuate and linear tapers presently claimed.

Regarding the limitations set forth in present claims 5-9, they are considered to distinguish further over the patent claims only with respect to the perspective of the consideration of the assembly. Inasmuch as the subject matter of the patent claims may be considered from any perspective,

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it would have been obvious to have considered any of the sides of the support members claimed as a front, left, back or front side.

Additionally, it is both known to make outer wraps of transparent material and outer wraps of opaque material, depending on whether viewing the container of the wrap is important. Accordingly, it would have been obvious in view of this to have made the film of the patent claims either opaque or transparent depending on whether it is desirable to display the containers.

11) Claim 10-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No 6,588,594 as applied above, and further in view of Roth (4,119,202). The reference of Roth at 36,38 suggests that adjacent support members of a package assembly may be have adjacent walls. Additionally each of the support members 14-18 includes a short front wall (48) and tapering side walls (36,38) and a taller back wall. This apparently permits separation of the support members without causing a non-walled opening in any support member, through which a container (20) might inadvertently pass (see Fig. 2). The shorter front wall apparently permits display of the containers (20). Accordingly, it would have been obvious in view of these reasons and Roth to have provided the walls of adjacent support members of the patent claims adjacent to each other, with a shorter front wall and tapering side walls.

12) Claims 1-9 and 34-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable

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over the claims of copending Application No 10/388,100. Although the conflicting claims are not identical, they are not patentably distinct from each other because inasmuch as ('100) claim 3 includes all or most of the subject matter set forth in many the present claims, and any difference would have been obvious, it would have been obvious to have made the invention of the present claims in view of the patent claims. ('100) claim 3 calls for first and second support members, a tapering support member wall for each support member, a support surface, plural containers on the support surfaces, a pad on the containers a film at least partially encapsulating the assembly of the support members containers, and pad.

Regarding present claim 3, which calls for the taper of the walls to be an arcuate taper, the description refers to this as a style of taper. Moreover, regarding claim 4 the recited linear taper would appear to be the opposite kind of style. A change in aesthetic design, however, generally will not support patentability (see In re Seid, 73 USPQ 431). Accordingly, it would have been obvious in view of this to have made the taper of any the walls of the ('100) claims with any shape/style, including the arcuate and linear tapers presently claimed.

Regarding the limitations set forth in present claims 5-9, they are considered to distinguish further over the ('100) claims only with respect to one's perspective of the consideration of the assembly. Inasmuch as the subject matter of the patent claims may be considered from any perspective, it would have been obvious to have considered any of the sides of the support members claimed as a front, left, back or front side.

Additionally, it is both known to make outer wraps of transparent material and outer wraps of opaque material, depending on whether viewing the



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container of the wrap is important. Accordingly, it would have been obvious in view of this to have made the film of the ('100) claims either opaque or transparent depending on whether it is desirable to display the containers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

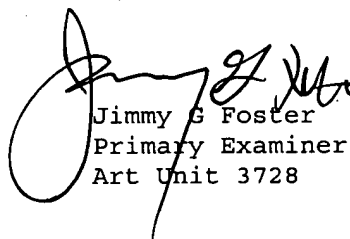
13) Claim 10-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/388,100 as applied above, and further in view of Roth (4,119,202). The reference of Roth at 36,38 suggests that adjacent support members of a package assembly may be have adjacent walls. Additionally each of the support members 14-18 includes a short front wall (48) and tapering side walls (36,38) and a taller back wall. This apparently permits separation of the support members without causing a non-walled opening in any support member, through which a container (20) might inadvertently pass (see Fig. 2). The shorter front wall apparently permits display of the containers (20). Accordingly, it would have been obvious in view of these reasons and Roth to have provided the walls of adjacent support members of the (100) claims adjacent to each other, with a shorter front wall and tapering side walls.

14) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G. Foster whose telephone number is (571) 272-4554. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jimmy G Foster  
Primary Examiner  
Art Unit 3728

JGF  
19 July 2005